

REMARKS

In the Claims:

In the following, the Examiner's comments are included in bold, indented type, followed by the Applicant's remarks:

3. Claim 26 is objected to because of the following informality: On line 1 of claim 26, replace "comprising" with --comprising:-- after "apparatus". Appropriate correction is required.

Applicant made the requested change.

5. Claims 1, 19, 34, and 35 are were rejected under 35 U.S.C. 103(a) as being unpatentable over Janky et al. (U.S. Patent # 5,777,580) in view of Westerlage et al. (U.S. Patent # 5,826,195).

Consider claims 1 and 19, Janky et al. clearly show and disclose a method and a vehicle location system (triggerable location-reporting apparatus) for use in an environment including: satellites 35A-D (source) outputting Global Positioning Satellite (GPS) System signals; a Vehicle Location Service Center (VLSQ 15 (source) outputting an interrogation (trigger) signal (IS); a cellular base station connected through a network to a gateway; the cellular base station being configured to expect a Reverse Control Channel (RECC) signal including a Mobile Identification Number (MIN) and an Electronic Serial Number (ESN) (column 7 line 6 – column 8 line 4), the vehicle location system (triggerable location-reporting apparatus), and respective method, comprising:

a location determination system (LDS) receiver/processor 31 (GPS receiver) responsive to the GPS signals for producing GPS data when enabled (abstract, figures 1, 2, 5, and 6, and column I I lines 15-19);

an IS communications transmitter or responder means 27 (cellular network transmitter) coupled to the LDS receiver/processor 31 (GPS receiver) for formatting and transmitting, when enabled, a RECC signal including the formatted GPS data to the gateway (abstract, figures 1, 2, 5, and 6, and column 5 lines 42-53);

an IS communications receiver 21 (trigger signal receiver) responsive to the IS (trigger signal) for producing an enable signal (abstract and figures 1, 2, 5, and 6);

a controller 25 (enable controller) coupled to the LDS receiver/processor 31 (GPS receiver), the IS communications transmitter or responder means 27 (cellular network transmitter), and the IS communications receiver 21 (trigger signal receiver) (figures 1, 2, 5, and 6);

the controller 25 (enable controller) being configured to wake-up (enable, switch on), by means of a first switchable power signal, the LDS receiver/processor 31 (GPS receiver) and, by means of a second switchable power signal, the IS communications transmitter or responder means 27 (cellular network transmitter) when it receives an enable signal from the IS communications receiver 21 (trigger signal receiver); and

inherently, the controller 25 (enable controller) being configured to put back to sleep (disable, switch off) the LDS receiver/processor 31 (GPS receiver) and the IS communications,, transmitter or responder means 27 (cellular network transmitter) in order to conserve electrical power (abstract, figures 1, 2, 5, and 6, column 11 lines 26-40, column 12 lines 24-26, and claims 1-8).

Furthermore, Janky et al. clearly disclose that the LDS receiver/processor 31 (GPS receiver) can only provide to the IS communications transmitter or responder means 27 (cellular network transmitter) information sufficient to determine the vehicle present location (column 5 lines 26-30 and column 12 lines 8-15 and 26-31) which clearly suggests that the LDS receiver/processor 31 (GPS receiver), by means of some kind of data selector, selects less than all of the GPS data to produce selected GPS data (i.e., information sufficient to determine the vehicle present location) that is provided to the IS communications transmitter or responder means 27 (cellular network transmitter) for transmission to a selected IS contact receiver 43.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to slightly modify the teachings of Janky et al. in order to, and by following the clear suggestion provided by Janky et al., further specify a data selector for performing the above-mentioned task of producing selected GPS data.

However, Janky et al. do not specifically disclose that the RECC signal includes the formatted GPS data in the place normally occupied by the ESN and a MIN that will cause the cellular base station to send a Registration Notification Invoke signal including the formatted GPS data to the gateway.

Westerlage et al. clearly show and disclose a data messaging system and a data messaging unit 16, equipped with a cellular transceiver 38, that generates a data message (e.g., GPS data) in response to a reporting event (trigger signal). Said data message (e.g., GPS data) is transmitted by the cellular transceiver 38, in a Reverse Control Channel, by altering the Electronic Serial Number and the Mobile Identification Number of the cellular transceiver 38. A cellular base station receives the data message and, after recognizing the altered identifier, forwards the message to a platform (gateway) (abstract, figures 1 and 2, column 1 line 62 - column 2 line 30, column 6 lines 5-65, column 9 lines 4-17, and column 10 line 16 - column 12 line 4).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to further modify the teachings of Janky et al. with the teachings of Westerlage et al. in order to provide a triggerable location-reporting apparatus that takes advantage of existing communications protocols as well as existing cellular communications equipment at a reduced cost and complexity when communicating data messages in the place normally occupied by the ESN and the MIN, as recognized by Westerlage et al. (column 2 lines 6-13).

Applicant respectfully traverses this rejection. Janky does not show or suggest selecting less than all of the GPS data to produce selected GPS data, as required by claim 19, and does not show or suggest a data selecting device for selecting less than all of the location data to include in the location signal, as required by claim 26. Contrary to the Examiner's understanding, Janky's LDS receiver/processor 31 does not hint at, "by means of some kind of data selector, select[ing] less than all of the GPS data to produce[] selected GPS data." Office Action at 5.

In its summary, Janky teaches that "[t]he vehicle present location can be determined entirely by the on-board LDS signal receiver/transmitter, or information sufficient to determine the vehicle present location can be transmitted to a processor at the selected IS contract receiver for final processing and presentation." Col. 5, lines 26-30. A person of ordinary skill in the art at the time this application was filed would understand this to mean that the LDS receiver/transmitter would transmit partly processed vehicle present location information, not that it would transmit less than all of the vehicle present location information, as suggested by the Examiner. Applicant's interpretation is reinforced by one of the other excerpts from Janky cited by the Examiner: "Alternatively, the LDS receiver/processor may partly process vehicle present location information and provide partly processed vehicle present location information, with the remainder of the processing to determine the vehicle present location information being performed at the IS contact receiver." Col. 12, lines 10-15 (emphasis added). Thus, Janky teaches providing partly processed vehicle present location information, and does not show or suggest selecting less than all of the GPS data, as required by claim 1, or a data selecting device for selecting less than all of the location data to include in the location signal, as required by claim 19.

Further, Westerlage does not does not show or suggest selecting less than all of the GPS data, as required by claim 1, or a data selecting device for selecting less than all of the location data to include in the location signal, as required by claim 19. Consequently, the combination of Janky and Westerlage proposed by the Examiner would be missing the same element. Therefore, claims 1 and 19 would not have been obvious to a person of ordinary skill in the art at the time this application was filed over Janky in view of Westerlage. This rejection should be withdrawn and claims 1 and 19 should be allowed, which action is respectfully requested.

Consider claims 34 and 35, and as applied to claims 1 and 19 above, although Janky et al. as modified by Westerlage et al. fail to specifically disclose that the selected GPS data is reorder, a person of ordinary skill in the art of wireless communications systems would have been clearly motivated by, for example, the current communication system being used, to reorder the selected GPS data in a way that best fits the communication system currently in use by the vehicle location system (triggerable location-reporting apparatus).

Applicant respectfully traverses this rejection. As the Examiner admits, neither Janky nor Westerlage show or suggest reordering the selected GPS data, as required by claims 35 and 36, or a data selector that reorders data, as required by claim 35. Applicant assumes that the Examiner

is asserting that reordering selected GPS data and a data selector that reorders data are common knowledge in the art. Applicant respectfully traverses this assertion and requests that the Examiner cite a reference in support of his position. MPEP § 2144.03.

In any case, claims 34 and 35 depend from claims 1 and 19, respectively, and are patentable for all the reasons discussed above with respect to claims 1 and 19. This rejection should be withdrawn and claims 34 and 35 should be allowed, which action is respectfully requested.

6. Claims 26 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janky et al. (U.S. Patent # 5,777,580).

Consider claim 26, Janky et al. clearly show and disclose a vehicle location system (triggerable location-reporting apparatus) comprising:

a location determination system (LDS) receiver/processor 31 (location-signal generating device) configured to produce a location signal including location data when enabled (abstract and figures 1, 2, 5, and 6);

an interrogation signal (IS) communications transmitter or responder means 27 (telemetry transmitter) coupled to the LDS receiver/processor 31 (location-signal generating device) configured to transmit the location signal when enabled (abstract, figures 1, 2, 5, and 6, and column 5 lines 42-53); and

a controller 25 (enable controller) configured to wake-up (enable) the LDS receiver/processor 31 (location-signal generating device) and the IS communications transmitter or responder means 27 (telemetry transmitter) when it receives an interrogation (trigger) signal (IS) and, inherently, to put back to sleep (disable) the LDS receiver/processor 31 (location-signal generating device) and the IS communications transmitter or responder means 27 (telemetry transmitter) after the IS communications transmitter or responder means 27 (telemetry transmitter) transmits the location signal (abstract, figures 1, 2, 5, and 6, column 11 lines 26-40, and claims 1-8), since Janky et al. clearly disclose a power saving mode embodiment in which the LDS receiver/processor 31 (location-signal generating device) is kept in a "sleep" mode to conserve power until the IS receiver receives and responds to the specified IS (abstract lines 18-20) and that the LDS receiver/processor 31 (location-signal generating device) is awakened by the controller (enable controller) only when a trigger event occurs (column 11 lines 31-40) and the IS responder/transmitter means 27 (telemetry transmitter) can contact the IS contact receiver only once (column 12 lines 24-26).

Furthermore, Janky et al. clearly disclose that the LDS receiver/processor 31 (GPS receiver) can only provide to the IS communications transmitter or responder means 27 (cellular network transmitter) information sufficient to determine the vehicle present location (column 5 lines 26-30 and column 12 lines 8-15 and 26-31) which clearly suggests that the LDS receiver/processor 31 (GPS receiver), by means of some kind of data selecting device, selects less than all of the GPS data to produce selected GPS data (i.e., information sufficient to determine the vehicle present location) that is provided to the IS communications transmitter or responder means 27 (cellular network transmitter) for transmission to a selected IS contact receiver 43.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to slightly modify the teachings of Janky et al. in order to, and by following the clear suggestion provided by Janky et al., further specify a data selecting device for performing the above-mentioned task of producing selected GPS data.

Applicant respectfully traverses this rejection for, among other reasons, the rationale stated by Applicant in the appeal of the parent case, United States Patent Application Serial No. 09/206,627, which is repeated below in block indent format and reasserted here:

Janky does not teach disabling its telemetry transmitter after transmitting a location signal, as required by Claim 26. Janky discloses that "the controller 25 causes the IS responder/transmitter means 27 and associated IS antenna 29 to contact a selected IS contact number at an IS contact receiver 43." (column 12, lines 16-18, emphasis added) Subsequently, "the IS responder/transmitter means 27 transmits the vehicle location information in a short burst of data contained in an IS response signal, in step 63." (column 12, lines 20-22, emphasis added) As can be seen, Janky uses "contact" to describe creating the communications link between the IS responder/transmitter means 27 and the IS contact receiver 43, and "transmit" to describe transmitting the vehicle location information.

In the pivotal language relied on by the examiner, "the IS responder/transmitter means 27 may contact the IS contact receiver 43 only once, as desired," column 12, lines 25-26, Janky used the verb associated with setting up the communications link ("contact"), not the verb associated with transmitting the vehicle location information ("transmit"). Thus, this language is referring to setting up a communications link only once, not transmitting the vehicle location information only once. Even if the IS responder/transmitter means 27 contacts the IS contact receiver 43 only once, there is nothing in Janky that suggests that it transmits the vehicle location information only once during the single contact with the IS contact receiver. Thus, Janky does not expressly or inherently teach or suggest that the controller disables the location-signal generating device and the telemetry transmitter after the telemetry transmitter transmits the location signal, as required by claim 26.

In the Examiner's Answer in the appeal of the same rejection in the parent case, United States Patent Application Serial No. 09/206,627, the Examiner relied on the following sentence from *Janky*'s specification:

"The vehicle present location information can be updated continuously or intermittently, or the IS responder/transmitter means 27 may contact the IS contact receiver 43 only once." Column 12, lines 23-27.

According to the Examiner, this sentence "means that the vehicle present location information can be either:

- a) continuously transmitted to the IS contact receiver 43;
 - b) intermittently transmitted to the IS contact receiver 43; or
 - c) transmitted only once to the IS contact receiver 43, as desired."
- Examiner's Answer at 13-14 (emphasis removed).

A better understanding of this sentence can be derived from a subsequent sentence in the same paragraph:

"When the IS response signal is received, preferably with acknowledgement, at the IS contact receiver 43, the IS responder means 43 [sic 27] may discontinue sending vehicle present location information or may send such information continuously or intermittently." Column 12, lines 38-42

This statement implies that within a single contact, present location information will be transmitted until acknowledged and thereafter continuously, intermittently, or not at all, perhaps depending on the acknowledgement signal. There is, however, no teaching in *Janky* that the contact is terminated after transmitting the present location information signal. And, because the IS responder/transmitter means 27 must be enabled to maintain the contact, *Janky* does not teach disabling the IS responder/transmitter means 27 after transmitting the present location information. Consequently, *Janky* does not teach that its telemetry transmitter is disabled after transmitting the location information, as required by Claim 26. Therefore, Claim 26 is patentable over *Janky*.

For these same reasons, claim 26 in the present application is patentable over *Janky*. The Examiner's rejection of claims 26 and 36 (which depends from claim 26) should be withdrawn and claims 26 and 36 should be allowed, which action is respectfully requested.

Even assuming that *Janky* teaches disabling its telemetry transmitter, which Applicant disputes, as set out immediately above, *Janky* does not teach, explicitly or inherently, that the controller does the disabling. The Examiner implicitly admits *Janky* contains no explicit teaching by arguing that the teaching is inherent.

Further, *Janky* does not inherently teach that the controller does the disabling. "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. ... Inherency ... may not be established by probabilities or possibilities. The mere fact that a certain fact *may* result from a given set of circumstances is not sufficient."¹ *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 20 USPQ2d 1746 (Fed. Cir. 1991). The controller in *Janky* does not necessarily disable the telemetry transmitter after the telemetry transmitter transmits the location information nor is this a "natural result flowing from the operation as taught" (using language from *Continental Can* likely to be cited by the Examiner).

While there is some indication in *Janky* that the controller enables the LDS signal receiver/processor 31, Column 11, lines 31-40, there is no teaching or suggestion that the LDS signal receiver/processor 31 and the IS responder/transmitter means 27 are disabled once they are enabled, as described above. Even if they are, however, there is no teaching or suggestion in *Janky* that the controller does the disabling.

It is just as likely, if not more likely, that the controller is not involved and that the LDS signal receiver/processor 51 and the IS responder/transmitter means 27: (1) disable themselves; (2) are disabled by another device in the system, not the enable controller; or (3) are manually disabled. Thus, the requirement in Claim 26 that the controller disable the location-signal generating device and the telemetry transmitter after the telemetry transmitter transmits the location signal is not inherent in *Janky*.

This is even more clear in light of the fact that *Janky* indicates that the controller is optional, Column 12, lines 52-53 and 66-67, without describing a change in functionality with respect to enabling and disabling the LDS receiver/processor and the IS responder/transmitter means. Thus, even assuming *Janky* teaches disabling these components, it teaches away from having the controller do the disabling. Thus, *Janky* does not teach or suggest, explicitly or inherently, that the controller disables the location signal generating device and the telemetry transmitter after the telemetry transmitter transmits the location signal, as required by Claim 26.

¹ The Board recently relied on this same language in a non-precedential opinion in *Bronshtein v.*

Consequently, Claim 26 is patentable over *Janky* and should be allowed.

Claim 36 depends from Claim 26 and is patentable for at least the same reasons.

The rejections of Claims 26 and 36 should be withdrawn and claims 26 and 36 should be allowed, which action is respectfully requested

Further, as discussed above with respect to claims 1 and 19, *Janky* does not include a data selecting device for selecting less than all of the location data to include in the location signal, as required by claim 26. Therefore, claim 26 would not have been obvious to a person of ordinary skill in the art over *Janky* at the time this application was filed. Claim 26 is patentable over *Janky* and this rejection should be withdrawn and claim 26 should be allowed, which action is respectfully requested.

Consider claim 36, and as applied to claim 26 above, although *Janky et al.* fail to specifically disclose that the selected GPS data is reorder, a person of ordinary skill in the art of wireless communications systems would have been clearly motivated by, for example, the current communication system being used, to reorder the selected GPS data in a way that best fits the communication system currently in use by the vehicle location system (triggerable location-reporting apparatus).

Applicant respectfully traverses this rejection. As the Examiner admits, *Janky* does not show or suggest reordering the selected GPS data, as required by claims 35 and 36, or a data selector that reorders data, as required by claim 35. Applicant assumes that the Examiner is asserting that reordering selected GPS data and a data selector that reorders data are common knowledge in the art. Applicant respectfully traverses this assertion and requests that the Examiner cite a reference in support of his position. MPEP § 2144.03.

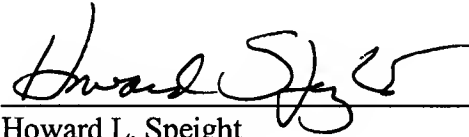
In any case, claim 36 depends from claim 26 and is patentable for all the reasons discussed above with respect to claims 26. This rejection should be withdrawn and claim 36 should be allowed, which action is respectfully requested.

SUMMARY

Applicant contends that all of the claims are now in condition for allowance, which action is requested. Applicant does not believe any fees are necessary with this submitting this response. Should any fees be required, Applicant requests that the fees be debited from deposit account number 02-0383.

Roser, Patent Interference 104,727 (Board of Patent Appeals and Interferences, January 2, 2002).

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Howard Speight", written over a horizontal line.

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Version With Markings to Show Changes Made

26. (Amended) A triggerable location-reporting apparatus comprising:
- a location-signal generating device configured to produce a location signal including location data when enabled;
 - a data selecting device for selecting less than all of the location data to include in the location signal;
 - a telemetry transmitter coupled to the data selecting device configured to transmit the location signal when enabled; and
 - an enable controller configured to enable the location-signal generating device and the telemetry transmitter when it receives a trigger signal and to disable the location-signal generating device and the telemetry transmitter after the telemetry transmitter transmits the location signal.